

### **REMARKS**

The non-final Office Action was issued on pending claims 1-18. Claims 1-18 stand rejected. In this Response, claims 1-18 have been cancelled without prejudice and claims 19-38 have been added. Thus, claims 19-38 are pending in the application.

Applicants invite the Examiner to call Applicants' Representative to discuss any issues with this application.

### **Claims**

This Application is a U.S. nationalization of International Application No. PCT/JP99/04630. Claims 1-18 originally filed in the present application were translated into the English language from the Japanese language international PCT application. Claims 1-18 have been canceled without prejudice and claims 19-38 have been added. The cancellation of the original claims and addition of the new claims is intended to place the claims in form for U.S. prosecution and to clarify the claims and not to narrow the claims. Claims have been canceled and new claims have been added merely as a matter of convenience rather than showing extensive revisions to the claims by strikethrough and underlining. Applicants submit that the cancellation and addition of claims is not being done for substantial reasons related to patentability or to surrender any subject matter.

### **Claim Objections**

At pages 2 and 3 of the Office Action, claims 1-18 were objected to as containing informalities. As discussed above, claims 1-18 have been canceled and claims 19-38 have been added to conform to U.S. practice. Accordingly, Applicants respectfully submit that the claim objections are moot.

As to claims 1, 6, 8, 9 and 15 mentioned in the Office Action, corresponding claims 19, 24, 26, 27 and 33, respectively, do not contain the objections mentioned in the Office Action.

### **Claim Rejections 35 USC §§ 102, 103**

As mentioned above, claims 1-18 have been canceled and claims 19-38 have been added to clarify the claims according to U.S. practice. Accordingly, the claims have not been amended in response to any prior art rejections. Applicants respectfully submit that new claims 19-38 render the rejections of claims 1-18 moot. However, in the interest of quickly moving the application to allowance, Applicants provide comments on the references relied on to reject the original claims.

At pages 3-5 of the Office Action, claims 1-2, 4-7 and 15 were rejected under 35 USC §102(a) as being anticipated by Mori et al. (EP 0 895 112 A1). At pages 5-8 of the Office Action, claims 3, 8-12, 16 and 18 were rejected under 35 USC §103(a) as being unpatentable over Mori et al. in view of Ishida et al. (EP 0 645 651 A1). At Office Action pages 8 and 9, claim 13 was rejected under 35 USC §103(a) as being unpatentable over Mori et al. in view of Hashimoto et al. (US 6,480,639). At Office Action page 9, claim 14 was rejected under 35 USC §103(a) as being unpatentable over Mori et al. in view of Hashimoto et al. and further in view of Kauffman et al. (US 4,987,164). At page 9 of the Office Action, claim 17 was rejected under 35 USC §103(a) as being unpatentable over Mori et al. in view of Ishida et al. and further in view of Official Notice.

Claim 19 pertains to an optical module and calls for "said walls of said positioning structure directly contact side faces of said mount". As shown, for example, in Fig. 4 of the present application, the walls of the protruding sections for positioning (positioning structures) 23 and 24 directly contact side faces of the mount 4. In contrast, in Mori et al., there are gaps between the side walls 8d of the second package 8 and the side faces of the substrate 2 as shown in Figs. 5 and 6. Further, Mori et al. provides gaps between the side walls 27d of the second package 27 and the side faces of the substrate 2 as shown in Fig. 16. Even further, there are gaps between the inner side walls of the package 35 and the side faces of the substrate 21 as shown in

Fig. 20 of Mori. Mori et al. also provides gaps between the inner side walls of the package 45 and the side faces of the substrate 41 as shown in Figs. 22 and 24.

Moreover, Ishida, Hashimoto et al. and Kauffman et al. do not disclose or suggest such a positioning structure as recited in Applicants' claim 19.

Therefore, Applicants' invention, as claimed in claim 19, is not anticipated by or obvious in view of any of those cited references, alone or in combination, and claim 19 is allowable.

Independent claims 25 and 38 pertain to optical modules and also recite features similar to those features in claim 19 discussed above. Therefore, claims 25 and 38 are also allowable.

Regarding claim 23 (corresponding to previously pending claim 5), the Office Action asserts that the present invention according to claim 5 is anticipated by Mori et al. However, Applicants respectfully disagree. The positioning stand recited in claim 23 (claim 5) is provided for positioning the optical fibers. Claim 23 calls for "said positioning structure to comprise a side face of said positioning stand provided so as to touch a side face of said mount and thereby position said mount." (emphasis added) Conversely, Mori et al. shows a front edge section 7a in Figs. 3 and 7 in which the front edge section 7a does not touch the substrate 2 for positioning the substrate 2. Accordingly, claim 23 is allowable.

Regarding claim 28 (corresponding to previously pending claim 10), the Office Action asserts that the present invention according to claim 10 is obvious in view of Mori et al. in combination with Ishida et al. However, Applicants respectfully disagree. The element indicated by reference numeral 113 in Fig. 49 of Ishida, et al., which was asserted to be a meshing section in the Office Action, is actually solder according to the description to Ishida et al. (column 28, line 30), which permanently fixes the optical fibers 1, lower plate 101, and upper plate 102 to each other. Conversely, claim 28 (claim 10) calls for "a meshing section meshing with said package side wall section." The Ishida et al. solder is not Applicants' claimed meshing section. Accordingly, claim 28 is allowable.

Regarding claim 30 (corresponding to previously pending claim 12), the Office Action asserts that the present invention according to claim 12 is obvious in view of Mori et al. in

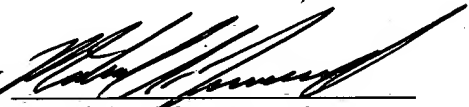
combination with Ishida et al. However, Applicants respectfully disagree. Claim 30 (claim 12) recites "tapered optical fiber insertion openings." The holes 7e and 7h shown in Fig. 12 of Mori et al., which were asserted to be tapered optical fiber insertion openings in the Office Action, are actually formed in a stepped shape. Accordingly, the Mori et al. stepped shape holes are not Applicants' claimed tapered optical fiber insertion openings. Thus, claim 30 is allowable.

### CONCLUSION

For the foregoing reasons, Applicants submit that the patent application is in condition for allowance and request a Notice of Allowance be issued.

Respectfully submitted,

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